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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,500	02/21/2001	Guillermo Lao	,111325-40	6754

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EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/788,500	Applicant(s) LAO ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 147-249 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 147-149, 153, 155-157, 195, 199-201, 205,

207-209, 247, and 249 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

Claims 1-146 have been previously canceled.

Claims 150-152, 154, 158-194, 196-198, 202-204, 206, 210-246, and 248 have been withdrawn previously.

Claims 147-249 are pending with claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 rejected as set forth below.

Response to Arguments

Applicant's arguments filed 10/12/2006 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment has necessitated the new grounds of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding specifically independent claims 147, 199, and 249, claims 147, 199, and 249 recite providing information to a plurality of distributor systems, the information including at least one of a description, metadata, content identifiers, publisher information, content repository, and a rights specification identifier, while further in the claim applicant uses the provided information and evaluates it to determine a distributor's interest in the content. The Examiner notes that, in the claimed instance, the information provided to the distributor systems must be the rights specification identifier, as opposed to merely "at least one" of the alternate pieces of information noted. In the event that the provided information includes only one (as minimally required by the "at least one" clause) of the noted pieces of information that is not the rights specification identifier, it is unclear how the distribution system is able to obtain and evaluate the rights specification identifier against the predefined rules. In other words, the fourth element of the claim requires that the provided information include the rights specification identifier because that is the information being evaluated against the predefined rules. However, the third element of the claim fails to show that the information being provided includes the identifier. To the contrary, the third element actually allows other information to instead be provided to the distributor in order to allow the distributor to determine if they are interested in specified content.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 147-149, 153, 155-157, 195, 199-201, 205, 207-209, 247, and 249 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the invention by iUniverse as demonstrated by the periodicals listed as PTO 892 references U, V, W, X, and Y (herein referred to as iUniverse) in view of Ginter et al. (US 5892900).**

Regarding claim 147, 892u-892y (collectively referred to as iUniverse herein) teach a

receiving, by a publishing system, a selection of content from a user of said publishing system, said selection identifying an item of content (see at least: 892u 8, 11; 892v 4, 9, 12-14; 892w Pages 2-3, 7-15; 892x 7, 11);

receiving, by a publishing system, a request to publish the selected content from the user of said publishing system (see at least: 892u 8, 11; 892v 4, 9, 12-14; 892w Pages 2-3, 7-15; 892x 7, 11);

providing, by said publishing system in response to the request from the user to publish content, information to a plurality of distributor systems, and information comprising at least one of a description of the content, metadata of the content, content identifiers, publisher information, content repository indication and rights specification identifier, said rights specification identifier indicating the rights that are available for distribution and sale (see at

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least: 892u 8; 892v 12-14; 892w Page 8; 892x 7); The Examiner notes that iUniverse publishes and promotes the authors' works to major retailers and booksellers (i.e. *plurality to distributor systems*).

iUniverse teaches all of the above as noted as well as approving and promoting content for distribution. The iUniverse publishing and distribution system provides approval (i.e. a response indicating interest) for the provided content, and may do so on the basis that a work is not hate or pornographically related (i.e. *using pre-defined rules*) (see at least: 892u 8, 18; 892v 12-14; 892w Page 8, 13-14; 892x 7). Though iUniverse teaches such features, iUniverse does not expressly teach where, in determining distributor interest, *evaluating said rights specification identifier against said one or more pre-defined rules*.

In the same field of endeavor, Ginter teaches a system providing secure electronic transactions including digital rights protection (see at least: abstract). The VDE of Ginter can be used to protect the rights of parties (including publishers) who provide/create electronic content such as records, games, movies, newspapers, books, and the like (see at least: col. 1 lines 58-61, col. 4 lines). Ginter further teaches a content creator/provider (analogous to a *publisher*) negotiating with a distributor. The content creator specifies "rules and controls" of the content, which indicate such information as distribution and usage rights, and transfers the information to the distributor (see at least: Fig. 2, col. 56 lines 1-46). If no changes need to be made to the rights, a distributor may accept a creator's control information (i.e. distributor indicates it is *interested*). On the other hand, a distributor may wish to modify the control information and negotiate

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changes, indicating that they are not interested in being a distributor of the content according to the control information proposed by the creator (see at least: col. 328 lines 26-52). The negotiated VDE electronic agreement may also result directly from an automated electronic process during which a comparison of control terms to a table of stored conditions may be conducted (see at least: col. 19 lines 34-49, col. 19 line 59-col. 20 line 3). Thereby, Ginter teaches *upon receiving the information, generating a response using said provided information and one or more rules stored in a database including evaluating said rights specification identifier against said predefined rules, said predetermined rules used to determine interest, and providing the response to the publishing system.* Furthermore, if a distributor is determined to be interested, the content, content information, rules, control information, and the like (i.e. *metadata and rights specification*) is supplied to said distributor system, said metadata including *identification and descriptive data of said content, and said rights specification including at least one of usage rights and rights conditions* (see at least: col. 53 line 63-col. 54 line 10, col.56 lines 12-24, col. 200 lines 37-53, col. 278 line 59-col. 279 line 5).

It would have been obvious to one of ordinary skill in the art at the time of invention to have included *evaluating said rights specification identifier against said one or more pre-defined rules* as taught by Ginter in order to provide a system and method that facilitates secure electronic transactions and protection of electronic content such as books, music, movies, and the like (see at least: Ginter, abstract, col. 1 lines 58-61, col. 4 lines).

Additionally, the Examiner notes that methods are composed of actions/steps. Once the actions/steps that are positively recited of a method are satisfied, the method as a whole is satisfied regardless of whether or not other steps that are alternative steps or conditionally invocable under certain other hypothetical scenarios are satisfied (e.g. “if” and “only if”, “upon”, “when”, etc.). The Examiner further notes that, despite the cited teachings of iUniverse in view of Ginter, the limitations of “*upon receiving the information, generating...*” and “*upon said publishing system determining...*” are conditionally invocable. Because these limitations are not required, they do not move to distinguish the claimed invention from the references. [See Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991).]

Regarding claim 148-149, iUniverse in view of Ginter teaches:

(148) *wherein the distributor system further uses pre-defined rules to perform at least one of narrowing the rights defined by the rights specification and changing conditions defined by the rights specification, resulting in customized rights to offer a rights consumer* (see at least: Ginter, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

(149) *wherein the pre-defined rules comprise at least one of content type preferences, rights and conditions, preferences, content topics and publishers* (see at least: 892u 18; 892v 12; 892w Pages 7-14; Ginter, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

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Regarding claim 153, 155-157, 195, iUniverse in view of Ginter teaches:

(153) *wherein the rights specification includes at least one of the right to print, view, play, extract, and export* (see at least: 892w Pages 7-11; 892x 8; Ginter, abstract, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

(155) *creating, by the publishing system, the rights specification* (see at least: 892u 18; 892v 12; 892w Pages 7-14; Ginter, abstract, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

(156) *wherein the rights specification is created, based upon at least one of a user profile, a default rights specification, inference rules, and an analysis of the selected content* (see at least: 892u 18; 892v 12; 892w Pages 7-14; abstract, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

(157) *wherein the rights specification includes at least one usage right and a condition upon which the usage right is contingent* (see at least: 892u 18; 892v 12; 892w Pages 7-14; abstract, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

(195) *wherein the rights specification includes information regarding the specific rights granted to the content if a given set of conditions is satisfied* (see at least: 892y 13; Ginter, abstract, Fig. 2, col. 56 lines 1-46, col. 19 lines 34-49, col. 19 line 59-col. 20 line 3, col. 328 lines 26-52).

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Regarding claims 199-201, 205, 207-209, 247, and claim 249, the limitations set forth these claims closely parallel the limitations set forth in claims 147-149, 153, 155-157, and 195.

These claims are thereby rejected under the same rationale.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
December 11, 2006


YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Continuation of Disposition of Claims: Claims withdrawn from consideration are 150-152, 154, 158-194, 196-198, 202-204, 206, 210-246 and 248.